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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,016	07/24/2006	Toyoki Kunitake	2870-0305PUS1	8054
2292	7590	11/30/2007	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			PATEL, REEMA	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			2812	
			NOTIFICATION DATE	DELIVERY MODE
			11/30/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	Application No. 10/550,016	Applicant(s) KUNITAKE ET AL.	
	Examiner Reema Patel	Art Unit 2812	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/23/05, 8/7/07</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 9-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/8/07.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

3. The information disclosure statements (IDS) were submitted on 9/23/05 and 8/07/07. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kunitake et al. (U.S. 2002/0190251 A1).

6. Regarding claims 1 and 8, Kunitake et al. discloses a method for producing a dielectric insulating thin film ([0101]), comprising:

- A step (A) of making a substrate having a hydroxyl group in its surface or having a hydroxyl group introduced into its surface, adsorb a metal compound having a functional group capable of reacting with a hydroxyl group for condensation and capable of forming a hydroxyl group through hydrolysis ([0012], [0032]);
- A step (B) of removing the excessive metal compound from the substrate surface ([0012]);
- A step (C) of hydrolyzing the metal compound to thereby form a metal oxide layer having a hydroxyl group in the surface thereof ([0012]);
- A step (D) of treating the above-mentioned layer according to any one treating method selected from the group consisting of oxygen plasma treatment, ozone oxidation treatment, firing treatment and rapid thermal annealing treatment to thereby obtain a dielectric insulating thin film ([0012]).

7. Regarding claim 2, Kunitake et al. discloses the metal compound is a transition metal compound ([0066]-[0067]).

8. Regarding claim 3, Kunitake et al. discloses between the step (C) and the step (D), a step (E) of making the metal oxide layer formed in the step (C) adsorb an organic compound capable of forming a functional group that may be adsorbed by a metal compound, and a step (F) of removing the excessive organic compound from the surface of the metal oxide layer to thereby form an organic compound layer ([0012]).

9. Regarding claim 5, Kunitake et al. discloses repeating steps (A) to (C) or steps (E) and (F) ([0012]).

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10. Regarding claim 7, Kunitake et al. discloses at least two layers of metal oxide layer contain different types of metal compounds ([0053], [0091]).

### ***Allowable Subject Matter***

11. Claims 4 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claim 4 contains allowable subject matter because of the limitation of adsorbing a rare earth metal ion onto the hydroxyl group of the metal oxide formed in step (C), removing excess rare metal ion, and then hydroxylating the adsorbed rare earth metal ion. Claim 6 depends on claim 4.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reema Patel whose telephone number is 571-270-1436. The examiner can normally be reached on M-F, 8:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lebentritt can be reached on 571-272-1873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RSP

  
MICHAEL LEBENTRITT  
SUPERVISORY PATENT EXAMINER